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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,585	03/01/2002	Takuma Saito	H07-137800M/NHK	8975

7590 03/23/2004  
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Suite 200  
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EXAMINER
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LOPEZ, MICHELLE

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 03/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/085,585

Applicant(s)

SAITO ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 9, 11, 13 and 15-23 is/are rejected.
- 7) ☐ Claim(s) 5, 7, 10, 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/13/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2003 has been entered.
2. Claim 14 has been canceled.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

### ***Claim Objections***

4. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The feature of a projection on the fixed gear support jig is claimed on claim 3. Therefore, the dependency of claim 9 should be on claim 3 instead of claim 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6, 8-9, 11, 13, 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki (US Pat. 5,601,149) in view of Hosoya (US 5,873,786).

Kawasaki'149 discloses the invention as claimed including an impact tool powered by a driving source with a motor "M", a speed reduction mechanism "21", a striking mechanism portion (see Fig. 2) for converting the rotational power into a striking force, an end tool "16" for outputting the striking force and a rotation force, and an impact damping mechanism to damp the striking force in the axial direction (col.2, lines 58-63). Kawasaki'149 does not specifically state an impact damping mechanism for damping an impact on the speed reduction mechanism portion in a direction of rotation of the speed reduction mechanism. However, Hosoya'786 teaches an impact damping mechanism (see Fig. 2) for the purpose of damping a impact force on the speed reduction mechanism portion in a direction of rotation "X" of the speed reduction mechanism (see Figs. 3A and 3B, also see col. 5, lines 8-18). In view of Hosoya'786, it would have been obvious to one having ordinary skills in the art to have provided Kawasaki's invention with an impact damping mechanism in order to damp an impact force on the speed reduction mechanism portion in a direction of rotation of the speed reduction mechanism.

Regarding claims 2, 4, 18, and 22, Kawasaki'149 does not disclose a projection formed on an outer surface of a fixed gear of the speed reduction mechanism, an impact damping member provided adjacent the projection, and a fixed gear support jig mounted in the housing. However, Hosoya'786 teaches a projection "5b" formed on an outer surface of a fixed gear "5" of the speed reduction mechanism, an impact damping member "6" provided adjacent

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the projection, and a fixed gear support jig "3" mounted in the housing (see Fig. 2) for the purpose of damping via the damping member "6" a rotational impact force acting on the speed reduction mechanism portion, wherein the rotational impact force is transmitted via a motor to the fixed gear's projection "5b" against a fixed gear support jig "3". In view of Hosoya'786, it would have been obvious to one having ordinary skills in the art to have provided Kawasaki's invention with a projection formed on a fixed gear of the speed reduction mechanism, an impact damping member provided adjacent the projection, and a fixed gear support jig mounted in the housing in order to damp a rotational impact force acting on the speed reduction mechanism portion.

Regarding claims 3, 9, 19, and 23, Kawasaki'149 does not specifically disclose a projection formed on a side surface of the fixed gear support jig. However, Hosoya'786 teaches projections "3e, 3f" formed on the side surface of the fixed gear support jig "3" for the purpose of pressing the impact damping members "6" against the projections "3e, 3f". In view of Hosoya'786, it would have been obvious to one having ordinary skills in the art to have provided Kawasaki's invention with projections formed on the side surface of the fixed gear support jig in order to press the impact damping members against the projections, thereby damping the rotational impact force imparted by the fixed gear to the fixed gear support jig.

Regarding claim 11, Kawasaki'149 as modified by Hosoya'786 does not disclose a projection on the fixed gear formed on a side surface. As can be seen in Hosoya's Fig. 2, the projection "5b" is formed on an outer surface. However, it would have been obvious to one having ordinary skills in the art to have provided a projection on the fixed gear formed on a side surface, as a matter of design choice, as both configurations can perform the same function of

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providing a projection on a speed reduction's fixed gear for the purpose of transmitting a rotational impact force through the projection to a fixed gear support jig.

***Allowable Subject Matter***

6. Claims 5, 7, 10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 703-305-8205. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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